



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/817,570

04/01/2004

Charles David Claude

50623.00384

3815

7590 01/12/2007  
Cameron Kerrigan  
SQUIRE, SANDERS & DEMPSEY L.L.P.  
Suite 300  
One Maritime Plaza  
San Francisco, CA 94111-3492

EXAMINER

GEORGE, KONATA M

ART UNIT

PAPER NUMBER

1616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/817,570	<b>Applicant(s)</b> CLAUDE, CHARLES DAVID	
	<b>Examiner</b> Konata M. George	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-59 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-53 and 55-59 is/are allowed.
- 6) ☒ Claim(s) 44 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

Claims 44-59 are pending in this application.

***Action Summary***

1. The rejection of claims 44-53 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7, 9 and 13 of US 6,780,424 is hereby withdrawn as applicant has filed a terminal disclaimer.
2. The rejection of claim 44 under 35 U.S.C. 103(b) as being anticipated by Lee et al. is being maintained for the reasons stated in the previous office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. (US 5,610,241).

Lee et al. discloses reactive graft polymers for use in surgical implants, pins, screws, etc. consisting essentially of a biodegradable homopolymer or copolymer backbone joined with a side chain amino group (abstract). Column 8, lines 32-44 teaches that a drug may be coupled to the amino acid grafted polymer.

***Response to Arguments***

4. Applicant's arguments filed October 12, 2006 have been fully considered but they are not persuasive.

Applicant argues that Lee et al. does not describe a coating using a graft polymer. The examiner disagrees. The definition of a graft polymer is a polymer that has a main chain and a side chain. Lee et al. teaches a biodegradable homopolymer or copolymer backbone joined with a side chain amino group. Applicant also argues that the coating does not have different degrees of solubility as to cause a phase separation. The examiner disagrees. It is the position of the examiner that the main chain homopolymers or copolymers (i.e. polyglycolic acid or glycolide-lactide) will have a different degree of solubility than a side chain of glycine, serine, etc. With these different degrees of solubility a phase separation will naturally occur.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1616

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 44 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 5,610,241).

***Determination of the scope and content of the prior art***

**(MPEP §2141.01)**

Lee et al. discloses reactive graft polymers for use in surgical implants, pins, screws, etc. consisting essentially of a biodegradable homopolymer or copolymer backbone joined with a side chain amino group (abstract). Column 8, lines 32-44 teaches that a drug may be coupled to the amino acid grafted polymer.

***Ascertainment of the difference between the prior art and the claims***

**(MPEP §2141.02)**

The prior art does not teach the medical device as a stent.

***Finding of prima facie obviousness***

***Rational and Motivation (MPEP §2142-2143)***

It is well known in the surgical arts that a stent is a surgical implant used in blood vessels. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the coating composition on a surgical implant such as a stent.

***Conclusion***

6. Claims 44 and 54 are rejected.
7. Claim 45-53 and 55-59 are allowed. The prior art does not teach the device as claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8AM to 6:30PM Monday to Thursday.

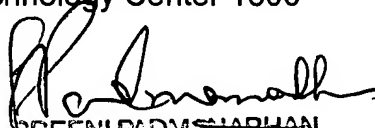
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Konata M. George  
Patent Examiner  
Technology Center 1600

(Fr)

Johann Richter, Ph.D., Esq.  
Supervisory Patent Examiner  
Technology Center 1600



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER

1/8/07